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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,719	11/19/2003	Randall J. Huebner	ACM 353	6328
23581	7590	06/01/2005	EXAMINER	
KOLISCH HARTWELL, P.C. 520 S.W. YAMHILL STREET SUITE 200 PORTLAND, OR 97204			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,719	<b>Applicant(s)</b> HUEBNER ET AL.	
	<b>Examiner</b> Anu Ramana	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- .

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 12-20, 24, 39-43, 45, 46 and 51-53 is/are rejected.
- 7) ☒ Claim(s) 5, 8-11, 21-23, 44 and 47-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/19/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/3/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 7, 13-14, 16, 18-20, 40-43, 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Huebner (US 5,658,283).

Huebner discloses a bone plate apparatus including first and second plate members (85, 15) with a ball joint 105 having a threaded fastener 45 connecting the two members and wherein each member has one or more openings configured to receive fasteners (Figs. 1, 2 and 10, col. 5, lines 12-67 and col. 6, lines 1-54).

With regard to the limitation, “contoured to fit onto the distal surface regions of the radius bone”, the plate members of the Huebner have a shape or contour that makes them capable of being placed on a radius bone.

Claims 40, 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Huebner (US 5,658,283).

Huebner discloses a bone plate apparatus including first and second plate members (15, 85), the second plate member 85 flaring as it extends away from first plate member 15; a ball joint 105 having a threaded fastener 45 connecting the two plate members; and wherein each member has one or more openings configured to receive fasteners (Figs. 1, 2 and 10, col. 5, lines 12-67 and col. 6, lines 1-54).

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Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bruchmann (US 6,053,915).

Bruchmann discloses a bone plate apparatus including two or more bone plates (1, 2) connected by an adjustable joint that can be fixed by a threaded fastener 5 (Fig. 1, col. 2, lines 63-67 and col. 3, lines 1-39).

With regard to the limitation, "contoured to fit onto the distal surface regions of the radius bone", the plate members of Bruchmann have a shape or contour that makes them capable of being placed on a radius bone.

Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as unpatentable over Christensen (US 3,488,779).

Christensen discloses a bone plate apparatus including two bone plates 46 and an adjustable pivotable joint 49 by which the angular disposition of each bone plate can be adjusted with respect to the other plate (Fig. 11, col. 2, lines 22-27 and lines 69-72, col. 5, lines 25-75 and col. 6, lines 1-40).

Christensen clearly states that his apparatus is characterized by its flexibility and ease of use in other parts of the body (col. 6, lines 47-40). Thus, it is the Examiner's position that the Christensen bone plates are contoured for placement onto distal surface regions of the radius bone which include flat regions.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (US 3,488,779), as applied to claim 13, further in view of Esser (US 6,096,040).

Christensen discloses a bone plate apparatus including two bone plates 46 and an adjustable pivotable joint 49 by which the angular disposition of each bone plate can be adjusted with respect to the other plate (Fig. 11, col. 2, lines 22-27 and lines 69-72, col. 5, lines 25-75 and col. 6, lines 1-40).

Christensen clearly states that his apparatus is characterized by its flexibility and ease of use in other parts of the body (col. 6, lines 47-40).

Esser teaches that it is known in the art to configure a bone plate to match the contour of a volar surface of a radius bone (Fig. 22, col. 2, lines 49-51 and col. 12, lines 30-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have contoured or "shaped" the Christensen bone plates 46 for placement on the volar surface of a radius bone since it was known in the art to shape bone plates for placement on the volar surface of the radius bone for fracture fixation.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-4, 6-7, 12, 18-20, 24, 40-43, 45, 46 and 51-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/717,399 ('399 herein) in view of Huebner (US 5,658,283).

Claim 4 ('399 herein) discloses all elements of the claimed invention except for a pivotal joint by which the angular disposition of the first and second plate members is adjustable by movement of the plate members about two or more nonparallel or orthogonal axes.

Huebner discloses a type of pivotal joint by which the angular disposition of first and second plate members can be adjusted about two or more nonparallel or orthogonal axes utilizing a threaded fastener. See previous discussion of Huebner.

Accordingly it would have been obvious to one of ordinary skill in the art to substitute a pivotal joint as, for example, taught by the Huebner reference for the pivotal joint of Claim 4 ('399) device wherein so doing would amount to mere substitution of one functionally equivalent structure for another within the same art and the selection of any of these structures would work equally well in the claimed device.

This is a provisional obviousness-type double patenting rejection.

Claims 13-17 and 39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/717,399 ('399 herein) in view of Huebner (US 5,658,283).

Claim 7 ('399 herein) discloses all elements of the claimed invention except for a pivotal joint by which the angular disposition of the first and second plate members is adjustable by movement of the plate members about two or more nonparallel axes.

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Huebner discloses a type of pivotal joint by which the angular disposition of first and second plate members can be adjusted about two or more nonparallel axes utilizing a threaded fastener. See previous discussion of Huebner.

Accordingly it would have been obvious to one of ordinary skill in the art to substitute a pivotal joint as, for example, taught by the Huebner reference for the pivotal joint of Claim 4 ('399) device wherein so doing would amount to mere substitution of one functionally equivalent structure for another within the same art and the selection of any of these structures would work equally well in the claimed device.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

Applicant's arguments filed on February 22, 2005 have been fully considered but are not persuasive with respect to claims 13 and 15-16 as discussed in the rejections above.

### ***Allowable Subject Matter***

The indicated allowability of claims 1- 4, 6-7, 12, 18-20 and 24 is withdrawn in view of the rejections made in this office action.

Claims 5, 8-11, 21-23, 44 and 47-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is

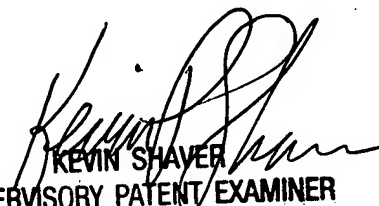
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(571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuadha Ramana*  
May 25, 2005

  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700